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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,717	07/11/2001	Herbert Uram		6761
7590	05/19/2004		EXAMINER	
c/o ANTHONY CASTORINA SUITE 207 2001 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202			GANEY, STEVEN J	
			ART UNIT	PAPER NUMBER
			3752	
			DATE MAILED: 05/19/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/901,717	URAM, HERBERT
	Examiner	Art Unit
	Steven J. Ganey	3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 March 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-16 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date _____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. Receipt is acknowledged of the reconsideration filed on March 4, 2004, which has been fully considered in this action.

### ***Election/Restrictions***

2. Applicant's election without traverse of claims 1-10 in Paper No. 3 is acknowledged, however, after further review the Restriction requirement was not warranted and is therefore withdrawn. An action directed to claims 1-16 follows.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-16 are rejected under 35 U.S.C. 101 because the disclosed invention is wholly inoperative and therefore lacking in credible utility. What has been disclosed is a concept more in the realm of speculation and conjecture than the reduction of an idea to a practical application based on science and technology.

Regarding claim 1, applicant claims a method of inhibiting or weakening the formation of hurricanes comprising detecting the onset of a hurricane in a region of open water and immediately cooling the surface water in the open water region. In order for an invention, process or otherwise, to have credible utility, the application disclosure must contain sufficient evidence and reasoning to permit a person of ordinary skill in the art to believe the asserted

utility. In this case, the application does not contain sufficient information to permit a person of ordinary skill in the art to believe that the process disclosed could achieve the asserted useful result, since applicant has shown no evidence of reducing the speculation and conjecture to practice in either a laboratory or natural environment setting.

Regarding claim 11, applicant claims a submarine including a water pump constructed such that its operation, upon detection of the onset of a hurricane, is effective to utilize the cooler water at said depth of the open water region to cool the water at the surface of the open water region. Again, as in claim 1, the application disclosure does not contain sufficient evidence and reasoning to permit a person of ordinary skill in the art to believe that the asserted utility or that the process disclosed could achieve the asserted useful result, since applicant has shown no evidence of reducing the speculation and conjecture to practice in either a laboratory or natural environment setting.

On the issue of compliance with the utility requirement of 35 U.S.C. 101, the following statement made by the Supreme Court of the United States is on point:

“This is not to say that we mean to disparage the importance of contributions to the fund of scientific information short of the invention of something “useful”, or that we are blind to the prospect that what now seems without “use” may tomorrow command the grateful attention of the public. But a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion. “[A] patent system must be related to the world of commerce rather than to the realm of philosophy.”

See, Brenner v. Manson, 148 USPQ 689, 696 (US SupCt 1966).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The standard for enablement is whether a person skilled in the art would have sufficient information from the application disclosure to make and use the claimed invention without undue experimentation. In this case, the amount of experimentation necessary to use the process disclosed would be undue. Undue experimentation would be necessary because:

- The claimed invention is broad and sweeping in scope.
- The nature of the invention is that of a large-scale environmental change.
- The state of the prior art offers no reasonable background from which to judge the feasibility of the invention.
- The level of one of ordinary skill in this art is best characterized as that of a theoretical scientist dealing in probabilities and possibilities rather than that of an engineer dealing in practical applications of technology.
- The outcome of the disclosed concept is entirely unpredictable.
- The application is devoid of working examples.

- The quantity of experimentation needed to use the invention based on the content of the disclosure can only be characterized as astronomical considering the lack of background information, past experimentation, and specific detail.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girden.

Girden discloses a method of inhibiting or weakening a hurricane by pumping cooler subsurface water to the surface, see col. 1, lines 43-62, except for the step of detecting the onset of a hurricane. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of detecting in the method of Girden, since the use of weather satellites are well known in the art and would be able to detect the onset of a hurricane in order to implement the method of Girden. Also, such a step of detecting the onset of a hurricane is considered old in the art in view of applicant's own admission on page lines 8-10.

9. Claims 1-3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bronicki et al in view of Girden.

Bronicki et al discloses a method of pumping cooler deeper water to the surface of warmer water in order to cool the surface and modify the weather, except for the step of

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detecting the onset of a hurricane and to use this method of cooling the surface to inhibit or weaken a hurricane. Girden discloses a method of inhibiting or weakening a hurricane by pumping cooler subsurface water to the surface, see col. 1, lines 43-62. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the apparatus and method of cooling the surface of the sea of Bronicki et al to inhibit or weaken the formation of a hurricane since Girden teaches that such a method can be used to inhibit or weaken the formation of a hurricane. As to the step of detecting the onset of a hurricane in the method of Bronicki et al, since the use of weather satellites are well known in the art, one of ordinary skill in the art would be able to detect the onset of a hurricane in order to implement the method of Bronicki et al. Also, such a step of detecting the onset of a hurricane is considered old in the art in view of applicant's own admission on page lines 8-10.

***Response to Arguments***

10. Applicant's arguments filed March 4, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that the Claims 1-16 are patentable under 35 U.S.C. 101, note that the examiner cited the statement made by the Supreme Court of the United States to emphasize the utility requirement of 35 U.S.C. 101, since this statement can be broadly used to address all inventions not just the invention of issue in *Brenner v. Manson*, 148 USPQ 689, 696 (US SupCt 1966). The examiner still maintains that the application disclosure does not contain sufficient evidence and reasoning to permit a person of ordinary skill in the art to believe that the asserted utility or that the process disclosed could achieve the asserted useful result,

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since applicant has shown no evidence of reducing the speculation and conjecture to practice in either a laboratory or natural environment setting.

In response to applicant's arguments that the specification meets the enabling requirement and the best mode requirement of 35 U.S.C. 112, first paragraph, note that all of applicant's arguments hinge on the concept that applicants method or apparatus will inhibit or weaken a hurricane to some degree or to some extent or have some affect. Note that such language further strengthens the examiner's position of maintaining the 35 U.S.C. 112, first paragraphs rejections since by definition "some" is defined to being an unspecified or indefinite number or quantity. Therefore, one of ordinary skill in the art would not be able to determine what is meant by inhibiting or weakening a hurricane to some extent or to some degree or have some affect to make and/or use the invention.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven J. Ganey whose telephone number is (703) 308-2585. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar, can be reached on (703) 308-2087. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

sjg

5/17/04

  
**STEVEN J. GANEY**  
**PRIMARY EXAMINER**

5/17/04